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Introduction

Rejections under 35 USC §112 ¶2nd

Applicant has amended claims 17 and 32, as well as claim 43 (which impacts claims 44-45), to address the comments in the Office Action. There is no doubt that these claims satisfy the definiteness requirement of 35 USC §112 ¶2nd.

Applicant requests the removal of these rejections.

The Nature of the Rejection

The Primary Examiner has rejected claims 15-17, 29-30, 32-34, 36-40 and 43-47 under 35 USC §102(e) “as being anticipated by Sollami (US 6397652).” This rejection

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appears to use the same rationale as the rejection set forth in Paragraph 4 of the Office Action of June 6, 2005 and was the subject of applicant's Appeal of August 5, 2005. Applicant submits that the claims are patentable over Sollami for the reasons like those set forth at pages 11-13 of applicant's Appeal Brief of October 5, 2005.² In this regard, it is clear that the structure of Sollami extends to a much greater extent (i.e., about 88.9 percent per Appeal Exhibit 4³) than the claims recite (i.e., between about 15 percent and about 30 percent of the thickness dimension of the retainer sleeve). Hence, Sollami cannot anticipate the rejected claims.⁴

Applicant requests the removal of the rejection under 35 USC §102(e) for the reasons set forth above including the arguments in the Appeal Brief.

Rejections under 35 USC §103(a)

Introduction

The Primary Examiner wrote that if applicant disagrees with the anticipation rejection, then the claims stand rejected under 35 USC §103(a). It is apparent that applicant disagrees with the anticipation rejection, and thus, applicant addresses the rejections under 35 USC §103(a) with which applicant also disagrees.

² Applicant points out that rather than filing an Examiner's Answer in the appeal wherein the substance of this rejection was at issue, the Primary Examiner issued a non-final Office Action (January 17, 2006) that contained only rejections under 35 USC §112 ¶2nd.

³ A copy of Appeal Exhibit 4 is attached as OA07-10-2006-Exhibit A.

⁴ It should be appreciated that each one of the independent claims recites that the amount of radial projection of the dimple (or dimples) beyond the cylindrical surface of the retainer sleeve is between about 15 percent and about 30 percent of the thickness dimension of the retainer sleeve. Thus, this limitation (which is absent from Sollami) is present in all of the dependent claims as well and forms a basis for allowance.

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For the Primary Examiner to make the leap from the admittedly missing limitation to assuming the limitation would have been obvious could only have been accomplished through hindsight. Hindsight is improper and the use thereof requires that the rejection be removed, and in this case, the claims allowed.

The requirement “at the time of the invention was made” is to avoid impermissible hindsight.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so.

The “motivation-suggesting-teaching” requirement protects against the entry of hindsight into the obviousness analysis.

At its core, our anti-hindsight jurisprudence is a test that rests on the unremarkable premise that legal determinations of obviousness, as with such

⁵ These decisions are Alza Corp. v. Mylan Labs., Slip Opinion No. 06-1019 (Fed. Cir. September 6, 2006), and Dystar Textilfarben GmbH v. C.H. Patrick Co., Slip Opinion No. 06-1088 (Fed. Cir. October 3, 2006).

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determinations generally, should be based on evidence rather than on mere speculation or conjecture.

At page 7 of the Slip Opinion, the Federal Circuit in Dystar Textilfarben GmbH wrote:

As we recently explained in Alza Corp. v. Mylan Labs., Inc., No. 06-1019, 2006 U.S. LEXIS 22616 (Fed. Cir. Sept. 6, 2006), the suggestion test – as our motivation-to-combine inquiry has come to be known – “prevent[s] statutorily proscribed hindsight reasoning when determining the obviousness of an invention.”

The current state of the law of obviousness mandates that the Primary Examiner present a valid basis (and not mere speculation or conjecture) to say that, “...it would have been obvious ...”. As will become apparent, that valid basis is absent.

Rejection of Claims 32-33, 36-37 and 44-45 under 35 USC §103(a)

The Primary Examiner has rejected claims 32-33, 36-37 and 44-45 under 35 USC §103(a). The Primary Examiner admits that Sollami, “... is silent about the specific sizing of the dimples as called for in ...” the claims under this rejection. The Primary Examiner then makes the following statement without any basis:

It would have been considered obvious to one of ordinary skill in the art to modify Sollami by making his dimples with the sizing dimensions called for in claims 32-33, 36-37 and 44-45 since such sizing facilitates tool retention and removal.

Applicant strongly submits that this reasoning is based on hindsight, and thus, is improper. These rejections must be withdrawn.

There is nothing in Sollami that teaches or suggests these numerical limitations, as well as that these limitations facilitate tool retention and removal. The principal focus of Sollami is on the cold-forming of a steel body for the tool. At Col. 1, lines 4-7, Sollami reads:

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The present invention relates to rotatable tool bodies of the type mounted in a machine for cutting hard surfaces and, in particular, an improved method of cold forging such tool bodies.

The fact that the focus is on the method is reinforced by the summary at Col. 2, line 66 through Col. 3, line 63, and especially at Col. 2, line 67-Col. 3, line 1 wherein one goal of Sollami is to provide "... an improved method of manufacturing an axially symmetric tool for use in such tool holders ...".

In Sollami, there is no emphasis on the ability of the retainer to help with the insertion or removal of the tool from the bore of the holder. The mere mention at Col. 1, lines 30-34 that it is desirable to, "... provide tools which are easily inserted into the holders ..." does not form the basis to modify the retainer of FIG. 15 of Sollami. It is only through hindsight that the Primary Examiner can even formulate his rationale for this rejection.

One their merits, these dependent claims are allowable over Sollami. Further, these claims depend from independent claims that present their own basis for allowance, and thus, are allowable for the reasons advanced in support of their corresponding independent claims. These reasons are expressed below.

Rejection of Claims 15-17, 29-30, 32-34, 36-40 and 43-47 under 35 USC §103(a)

The Primary Examiner has rejected claims 15-17, 29-30, 32-34, 36-40 and 43-47 under 35 USC §103(a) over Sollami. The Primary Examiner admits that Sollami, "... does not explicitly disclose the thickness ratio between the outwardly protruding surface and the sleeve." The Primary Examiner then makes the following statement without any basis:

It would have been considered obvious to one of ordinary skill in the art to modify Sollami by having the thickness ratio between the outwardly protruding surface and the sleeve be 15-30%, since such a modification allows for less crimping of the sleeve when installing in the bore of the block.

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The Primary Examiner repeats the rationale for claims 32-33, 36-37 and 44-45 as set forth in the above rejection. To address this aspect of the rejection, applicant reiterates the argument set forth above with respect to claims 32-33, 36-37 and 44-45.

In reference to the recitation (as found in each one of the independent claims) that the dimple or dimples extends beyond the cylindrical surface of the retainer sleeve is between about 15 percent and about 30 percent of the thickness dimension of the retainer sleeve, applicant submits that there is no way in the absence of hindsight that one skilled in the art would reduce the degree of dimple extension of Sollami from 88.9 percent⁶ of the thickness of the retainer sleeve to between about 15 percent and about 30 percent of the thickness dimension of the retainer sleeve as claimed by the pending claims.

The Primary Examiner has failed to provide any evidence of any motivation whatsoever that would cause one of ordinary skill in the art at the time of the invention to modify the dimples of FIG. 15 by reducing the extension thereof approximately 66.2% (59/89)⁷ to 83.1% (74/89)⁸ of the original length. It is only through the applicant's specification that there comes the suggestion to shorten the extension of the dimples relative to the thickness of the retainer. However, to use the specification to formulate the obviousness rejection is classic hindsight reasoning that cries out for the removal of these rejections.

Applicant strongly submits that these rejections find there basis in hindsight, and not in fact. Thus, they are improper and must be withdrawn.

⁶ This is the extent of the protrusion as calculated by applicant via an enlarged view of FIG. 15 and submitted to the Board of Appeals in the Appeal Brief as Appeal Exhibit 4.

⁷ This reduction would achieve the limitation that the extension is equal to 30% of the thickness of the retainer.

⁸ This reduction would achieve the limitation that the extension is equal to 15% of the thickness of the retainer.

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Conclusion

Applicant is disturbed at the continual rejections made by the Primary Examiner in this case. The multiplicity of non-final rejections continues to unduly prolong the prosecution. To better understand this aspect of the prosecution which is of concern to applicant, a listing⁹ of the substantive Office Actions are as follows:

- (1) non-final office action mailed September 11, 2002;
- (2) non-final office action mailed May 28, 2003;
- (3) non-final office action mailed January 22, 2004;
- (4) non-final office action mailed July 26, 2004;
- (5) non-final office action mailed February 1, 2005;
- (6) final office action mailed June 6, 2005 [applicant appealed this rejection including filing an Appeal Brief, but the Examiner did not file an Examiner's Answer];
- (7) non-final office action mailed January 17, 2006 [rejections only based on 35 USC §112 ¶2nd]; and
- (8) non-final office action mailed July 10, 2006 [the action to which this paper is responsive and wherein the only applied prior art is Sollami].

So far, there have been seven non-final office actions (including the pending office action) and one final office action. By the Primary Examiner issuing a non-final office action (January 17, 2006) after filing the appeal brief, the applicant has yet to have his "day in court" so to speak before an appellate body.

The time has come for allowance of the claims or for the Examiner to go through the appeal process by filing a Examiner's Response and not issuing another non-final office action. In this regard, applicant's undersigned attorney (Stephen T. Belsheim) and the assignee's Patent Counsel (Mr. Matthew W. Smith) would be pleased to interview the case

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Applicant looks forward to receipt of a Notice of Allowability and Notice of Allowance and Issue Fee Due in this application.

Stephen T. Belsheim
Registration No. 28,688

November 13, 2006

⁹ A copy of the PAIR printout is attached as OA07-10-2006-Exhibit B.